



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/751,545	12/30/2000	Christopher J. Spiegel	042390P10597	7429

7590 04/03/2003

Lisa N. Benado
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP
Seventh Floor
12400 Wilshire Boulevard
Los Angeles, CA 90025-1026

EXAMINER

CHEN, TE Y

ART UNIT	PAPER NUMBER
----------	--------------

2171

DATE MAILED: 04/03/2003

8

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action SummaryApplication No.
09/751,545Applicant(s)
SpiegelExaminer
T. ChenArt Unit
2171

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Dec 30, 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on Dec 30, 2000 is/are a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

Art Unit: 2171

DETAILED ACTION

1. Claims 1 - 30 are presented for examination.

Specification

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of 37 CFR 1.71(a)-(c):

(a) The specification must include a written description of the invention or discovery and of the manner and process of making and using the same, and is required to be in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which the invention or discovery appertains, or with which it is most nearly connected, to make and use the same.

(b) The specification must set forth the precise invention for which a patent is solicited, in such manner as to distinguish it from other inventions and from what is old. It must describe completely a specific embodiment of the process, machine, manufacture, composition of matter or improvement invented, and must explain the mode of operation or principle whenever applicable. The best mode contemplated by the inventor of carrying out his invention must be set forth.

© In the case of an improvement, the specification must particularly point out the part or parts of the process, machine, manufacture, or composition of matter to which the improvement relates, and the description should be confined to the specific improvement and to such parts as necessarily cooperate with it or as may be necessary to a complete understanding or description of it.

3. The specification is objected to under 37 CFR 1.71 because the specification failing to provide an adequate written description of the invention. Initially, the examiner notices the

Art Unit: 2171

separate nature of the written description requirement as contrasted to the enablement requirement of the first paragraph of 35 U.S.C. 112. See *In re Barker*, 559 F.2d 588, 194 USPQ 470 (C.C.P.A. 1977). The function of the written description requirement is to ensure that the inventor had possession, as of the filing date of the application here relied on, of the specific subject matter later claimed by him. See *In re Edwards*, 568 F.2d 1349, 196 USPQ 465 (C.C.P.A. 1978). The question is not merely one of literal support for the questioned claim language in the original disclosure, it is one of the disclosure of concepts. See *In re Wilder*, 736 F.2d 1516 222 USPQ 369 (Fed. Cir. 1984) and *In re Kaslow*, 707 F.2d 1366, 217 USPQ 1089 (Fed. Cir. 1983). It appears that applicant has attempted to incorporate a plurality of database tables (e.g., look-up tables, root sequence tables, sequence tables and end sequence tables, etc.) into his specification to thereby support claims to any combination or permutation of features therefrom. The fact that features are mentioned individually does not mean the proposed invention is innovative, since the associations among these different tables and the mechanism for applying these tables are missing. There must be some evidence within the application filed that applicant was in possession of the claimed combinations. Incorporation by reference of a dictionary does not constitute disclosure of a novel which uses only words from that dictionary. Similarly, without more, the stand alone database tables does not provide support for combining any features, regardless of what applicants may teach.

Art Unit: 2171

4. 35 U.S.C. 112, first paragraph, requires the specification to be written in "full, clear, concise, and exact terms." The specification is replete with terms which are not clear, concise and exact. The specification should be revised carefully in order to comply with 35 U.S.C. 112, first paragraph. Examples of some unclear, inexact or verbose terms used in the specification are:

1) at page 8, section 0025, in there, applicant discloses using look-up tables and handles to form a particular storage system as illustrated in the exemplary storage system in Figure 1. However, the examiner can not find any look-up tables or handlers in Fig. 1. Thus, applicant should provide the mapping of the disclosed look-up tables and handles in Fig. 1.

2) at pages 8-9, sections 0027-0029, applicant discloses unit headers 40, 60 having a plurality of fields to identify and describe the unit. However, the labels of the fields described in the specification do not match with the labels of the drawings. For example, at section 0028, line 6, which discloses a type field with label 60, but at Fig. 2A, the type field is labeled as 46, etc. As such, the applicant is requested to check and modify the mismatched label fields throughout the specification.

3) at pages 21-22, sections 0064-0067, applicant discloses a plurality of separated units, fragments, tables, appending and marking procedures. But he fails to show either the links among

Art Unit: 2171

these objects or how these objects being integrated into various disclosed software components or application programs.

5. All of the above diverse/undefined definitions reflect either unartful drafting, a conscious attempt to create ambiguity about the scop of the claims, or a desire to claim a wide variety of materials not described or enabled by the specification.

6. To be effective in showing possession of the invention, an incorporation of the apparatus and mechanisms derived from the disclosed tables or elements which specifically contribute to the claimed features and for what purpose should be reveled and mapped properly.

7. If applicants continue to prosecute the application, revision of the specification and claims to present the application in proper form is required. While an application can be amended to make it clearly understandable, no new subject matter can be added to the originally specification.

Drawings

8. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "VALID 52" and "VALID 54" [see Fig. 2A] have both been used to designate a VALID field. A proposed drawing correction or corrected drawings are required in

Art Unit: 2171

reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

9. Claims 1-30 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

10. As to claims 1, 11 and 21, the features cited in these claims either contradict with each other or not coherent. For example, the applicant claimed that “copying an original fragment of the file to update to form a new fragment with changed data” [see claim 1, lines 2-3, claim 11, lines 5-6; claim 21, lines 4-5], in there, the applicant fails to define a essential subject matter for implementing the changed data into a new fragment. By missing the essential subject matter, an ordinary copy operation will only produce a new file fragment without any changed data. Thus, it is contradict with the claimed limitation. Furthermore, the applicant claimed “creating a backup of an end sequence table (or sequence table) having a handle to point to the new fragment” [see claim 1, lines 4-5, claim 11, lines 7-8; claim 21, lines 6-7] and right after this limitation, the applicant cited “deleting the new fragment” [see claim 1, line 6, claim 11, line 9; claim 21, line 8]. As such, the created backup end sequence table (or sequence table) will have a handle

Art Unit: 2171

pointing to the deleted new fragment, which results in the creation of the backup table become meaningless. Thus, the instant disclosure does not enable a person of ordinary skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

11. As to claims 2-10, 12-20 and 22-30, these claims have the same defects as their base claims, hence were rejected for the same reason.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

12. Claims 1-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

13. As to claims 1, 11 and 21, the claimed “an original fragment” is indefinite. According to claim 11, a data object has at least two fragments which one is the claimed original fragment?

Art Unit: 2171

14. As to claims 2-4, 12-14 and 22-24, the set of claims has the same defects as their base claims. More ever, it is not understood how to mark, invalid and delete the claimed new fragment? Since the claimed fragment is deleted by the claimed system as specified in the set of independent claims. As such, the examiner concludes this set of dependent claims only limits the claimed system to mark, invalid and delete the original fragment.

15. As to claims 5, 15 and 25, the set of claims has the same defects as their base claims. More ever, since the claimed subject matter -- new fragment -- is deleted by the claimed system as specified in the set of independent claims, thus, the claimed limitations applied to the new fragment in the set of claims is not valid and should be canceled.

16. As to claims 6, 16 and 26, this set of claims has the same defects as their base claims. Furthermore, these claims have new problems. For example, it is not certain what is the structure of a handle [i.e., Is it constructed by a bit flag? Or it represents a piece of function code? Or others?].

17. As to claims 7, 17 and 27, the set of claims not only has the same defects as their base claims, but also introduces new issues. For example, the claimed "a previous handle" lacks proper antecedent basis. As such, it is uncertain how the claim system is able to mark this handler as invalid.

Art Unit: 2171

18. As to the rest of dependent claims, these claims not only have the same defects as their base claims, but also reveal new problems. For example, it is uncertain how the claimed "a chain of other sequence tables" is constructed [i.e., is it a linked list or circular chain or others?]; when how and why creating a backup copy of each of the other original sequence tables in the chain? Is the claimed "a chain of other sequence tables" and "the other original sequence tables in the chain" refer to the same set of tables or not? When, how, why and which claimed chains is hierarchically ranked in different level? What is the benefit to implement the claimed chains with more than one handle to point to more than one other sequence table? What does the claimed other sequence table refer to [i.e., Is it referred to the other end sequence table? Or the other intermediate sequence table? Or others?].

Claim Rejections - 35 USC § 102

19. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

Art Unit: 2171

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

20. Claims 1, 11 and 21, are rejected under 35 U.S.C. 102(e) as the best as the examiner is able to assertion, being anticipated by See et al. (U.S. Patent No. 6,226,728).

21. As to claims 1, 11 and 21, See et al. (hereinafter referred as See) disclosed a distributable computer storage system [e.g. see Fig. 1] with apparatus, steps and products to perform the following functions, comprising:

a) updating a file object with at least two fragments [e.g., see 210, Fig. 2, object headers 1-3 and data objects 1-3, etc] via data object manager [e.g., see 140, Fig. 1];

b) dynamically creating a plurality of database look-up tables including sequence tables for backing up the physical file object [e.g. see Fig(s). 3-8; col. 4, lines 4-64; col. 6, lines 50-58;];

c) delete the old data fragment or the dynamically created objects via the storage reclamation process [see col. 3, lines 35-45; col. 4, lines 4-14].

Art Unit: 2171

22. Regarding claims 2-10, 12-20 and 22-30, due to the ambiguity and inconsistency of these claims, the examiner was unable to apply art because the metes and bounds of the claimed subject matter is not understood. Accordingly, these claims have not been treated with respect to prior art.

Conclusion

23. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: See et al. (U.S. Patent No. 6,401,160) which disclosed a system for managing code or data boundary in a nonvolatile memory.

24. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Chen whose telephone number is (703) 308-1155. The examiner can normally be reached Monday through Friday from 7:30 A.M. to 4:30 P.M.


25. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic, can be reached at (703) 308-1436. The fax phone numbers for this group are: (703) 746-7238 (After Final Communication); (703) 746-7239 (Official Communications); and (703) 746-7240 (For Status Inquiries, Draft Communication).

Art Unit: 2171

26. Any inquiry of a general nature of relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-9600.

Susan Chen

March 27, 2003



SAFET METJAHIC
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100